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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,243	06/24/2003	Ali Rezai	12637/30	5654

7590

07/27/2006

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EXAMINER
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JOHNSON, SHEVON ELIZABETH

ART UNIT	PAPER NUMBER
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3766

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,243

Applicant(s)

REZAI ET AL.

Examiner

Shevon E. Johnson

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 9 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

**1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-2, 4-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino et al. (U.S. Patent No. 6,353,762) cited by applicant, in view of Goldman et al. (U.S. Patent No. 6,969,388) and Erickson et al. (U.S. Patent No. 7,047,084).**

In regards to claims 1-2, 4-8, 10 and 11, Baudino discloses a device comprising a cannula 22A and a plurality of leads 16-18, 920 having at least one electrode 16A-18A disposed thereon, opening 915, guide 905 (col. 2, lines 45-51; col. 4, lines 42-45 and 53-57; Figs. 3). Baudino teaches the actuation of the leads but the specification lacks a clear description of the actuator mechanism (col. 6, lines 16-27) and wherein at least one lead is quarter-round shaped. However, Goldman discloses a device comprising a cannula 30 having a proximal end, a distal end 40, and a lumen 60 extending to at least the distal end, an actuator mechanism 76 at least partially disposed in the lumen of the cannula; a plurality of leads having at least one electrode 58 disposed thereon, the plurality of leads being coupled to the actuator mechanism to reciprocate between a retracted position wherein the plurality of leads are radially constrained within the lumen and an extended position wherein the plurality of leads deploy radially outwardly into the tissue (col. 8, lines 39-67 and col. 9, lines 30-32; Fig. 4). Erickson teaches wherein the lead maybe quarter-rounded (col. 5, lines 15-46; figs. 3A-E).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Baudino as taught by Goldman to include a detailed description of the actuator mechanism and as taught by Erickson to configure the lead into any given shape in order to actuate the leads from the cannula into the tissue and selectivity activate subsections of brain volume.

**3. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino et al. (U.S. Patent No. 6,353,762) cited by applicant, in view of de al Rama (U.S. Patent No. 6,029,091).**

In regards to claims 1, 2, 4 and 6, Baudino discloses a device for modulating neural tissue except a clear description of the actuator mechanism (col. 6, lines 13-20). However, de la Rama discloses a device comprising a catheter 2 having a proximal end 4, a distal end 3, and a lumen 5 extending to at least the distal end, an actuator mechanism 7 or 8 at least partially disposed in the lumen of the cannula; a plurality of leads having at least one electrode 32 disposed thereon, the plurality of leads 21 being coupled to the actuator mechanism to reciprocate between a retracted position wherein the plurality of leads are radially constrained within the lumen and an extended position wherein the plurality of leads deploy radially outwardly into the neural tissue (col. 4, line 52 – col. 5, line 22, Figs. 1, 2, 6 and 7). Erickson teaches wherein the lead maybe quarter-rounded (col. 5, lines 15-46; figs. 3A-E).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Baudino as taught by de la Rama to include a detailed description of the actuator mechanism and as taught by Erickson to configure the lead into any given shape in order to actuate the leads from the cannula into the tissue and selectivity activate subsections of brain volume.

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***Allowable Subject Matter***

Claims 12-14 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shevon Johnson whose telephone number is (571) 272-2010. The examiner can normally be reached on M-F (8 a.m. - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shevon Johnson  
Art Unit 3766

  
Robert Pezzuto  
Supervisory Patent Examiner  
Art Unit 3766